

Applications section for incorporation in the present application. And, all other references in the specification to application serial numbers have been updated. Accordingly, this objection is believed to have been remedied.

**B. The Proper Filing Date for the Four and Five Layered Balls of the Present Invention is June 1, 1993**

In the Office Action, the Examiner contended that the effective filing date for the four layered ball (claims 1-19) is April 10, 1996 and that for the five layered ball (claims 20-36) is March 27, 1998.<sup>1</sup> Applicants respectfully disagree with the dates set forth by the Examiner.

The filing date for both the four and five layered golf balls (claims 1-36) is June 1, 1993, i.e., the filing date of U.S. Application Serial No. 08/070,510.

For the four layered golf ball, page 37, lines 18-23 of U.S. Application No. 08/070,510 discloses that the core of the multi-layered golf ball may be wound. Specifically, it states that "golf balls can be produced by injection molding or compression molding the inner cover layer about wound or solid molded cores to produce an intermediate golf ball[.]" (Emphasis provided.) Wound cores are produced by winding a relatively long elastic thread around a solid or liquid filled balloon center. Thus, U.S. Application Serial No. 08/070,510 discloses four layers within the multi-layered golf ball when counting the center layer, elastic thread layer, inner layer and outer cover layer.

U.S. Application Serial No. 08/070,510 incorporates by reference U.S. Patent No. 5,120,791 ("the '791 patent") on page 24 in which a multi-layered core and a layer above the core and a layer above the core and beneath the cover within the ball. Particularly, the '791 patent discloses "a separate layer beneath the cover and above the core as in U.S. Pat. No. 4,431,193, and other multi-layer and/or non-wound cores." (Col. 9, lines 45-48.) (Emphasis provided.) By combining the dual cover layer disclosed in 08/070,510 with the incorporated '791 patent, a five-layered golf ball, counting the inner and outer cover layer, a separate layer beneath the cover and above the core, and

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<sup>1</sup>For convenience, Applicants utilize the terminology of "four layered" and "five layered" golf balls adopted by the Examiner. Applicants do not concede or view any of these claims as limited to golf balls having only four or five layers. The claims may encompass balls having a greater number of layers.

a multi-layered core of at least two layers, is disclosed. Thus, support for a five layered ball in the present application can be derived from U.S. Serial Application No. 08/070,510 and by the '791 patent incorporated by reference.

**C. Rejection of Claims 1-7, 11, and 17-19 Under  
§§ 102 and 103 Has Been Overcome**

Claims 1-7, 11, and 17-19 were rejected under 35 U.S.C. § 102(e) as being anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as obvious over U.S. Patent No. 5,873,796 (Cavallaro).

With respect to the §§ 102 and 103 rejections, the Examiner stated:

Cavallaro suggests golf balls having an inner and outer cover. Either can be made of high acid ionomer (col. 3, line 23). The outer cover can be an ionomer, urethane, butyl rubber etc. (col. 8, line 23). The ball can have an intermediate layer between the cover and central core (i.e. a dual core).

Applicants respectfully disagree with the Examiner's rejections for at least two reasons: (1) the Cavallaro patent cannot be used against the present Application as prior art because the filing date of the present Application precedes the filing date of the Cavallaro patent and (2) the present invention is neither anticipated by nor obvious in light of the Cavallaro patent.

**1. The Filing Date of the Present Application  
Precedes the Filing Date of Cavallaro**

The Examiner's first basis of rejection for claims 1-7, 11, and 17-19 was 35 U.S.C. § 102(e). 35 U.S.C. § 102(e) states that a person shall be entitled to a patent unless:

the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for

patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent[.]

The Examiner's second basis for rejection of claims 1-7, 11, and 17-19 was 35 U.S.C. § 103(a). The effective date of a patent used as a § 103 reference is its filing date. *Richardson-Vicks Inc. v. Upjohn Co.*, 122 F.3d 1476, 1480 (Fed. Cir. 1997). A particular patent cannot be cited as a prior art reference under § 103 if the application being prosecuted has a filing date prior to that of the cited art. See *Stewart-Warner Corp. v. City of Pontiac, Michigan*, 767 F.2d 1563, 1570 (Fed. Cir. 1985).

Therefore, in order for a reference to be considered prior art under either §§ 102 or 103, that reference must have been known prior to the filing of Applicant's patent application. The filing date of the present application is June 1, 1993. The Cavallaro patent was filed on November 22, 1995, i.e., 29 months after the filing date of the present case. Thus, the Cavallaro patent cannot be used as prior art under either §§ 102 or 103.

**2. The Subject Matter of the Pending Claims is Neither Anticipated by, nor Obvious in Light of Cavallaro**

Notwithstanding the foregoing, the currently rejected claims 1-7, 11, and 17-19 are neither anticipated by, nor obvious in light of Cavallaro.

Independent claim 1 as amended herein, recites a golf ball comprising a particular dual core having a coefficient of restitution (COR) of at least 0.750. This dual core is specified in claim 1 as having a center component and a core layer disposed about the center component. This particular combination and configuration of core components is not disclosed or described in the cited reference Cavallaro.

Cavallaro discloses a solid core and mentions an intermediate layer between the cover and core in the Summary of the Invention (col. 3, line 35). However, Cavallaro no further discloses or teaches anything about such an intermediate layer. The mere fact that Cavallaro discloses the possibility of an intermediate layer does not mean that Cavallaro teaches the various compositions, combinations and advantages of such a layer. Particularly, Cavallaro does not disclose or teach a COR value for either a single solid core or a solid core and intermediate layer between the cover and

core. Cavallaro merely discloses COR values for the entire golf ball (see Table 3) and for the cover compositions (see Table 1).

As the Examiner knows, the COR in solid core balls is a function of the composition of the molded core and of the cover. In balls containing a dual core (i.e., balls comprising an interior spherical center component, a core layer disposed about the spherical center component, and a cover), the COR is a function of not only the composition of the cover, but also the composition and physical characteristics of the interior spherical center component and core layer. Both the dual core and the cover contribute to the COR in golf balls of the present invention.

Since the COR is a function of the composition of the core, a dual core composition will have a different effect on the overall COR value of a golf ball as opposed to a single core. Such is the case between the present application and Cavallaro. As a comparison between Cavallaro and the present application, Cavallaro describes in Table 3 a golf ball having a single solid polybutadiene core has a COR value of 0.821, whereas, for example, the COR values of the golf balls in the present application having dual cores are different from Cavallaro (See Table 14, page 53). Therefore, the claimed dual core of the present application having a COR value of at least 0.750 provides a different result than the cited reference Cavallaro.

For at least these reasons, independent claim 1 is patentable over Cavallaro, and since claims 2-7 and 11 are all dependent or ultimately dependent on amended claim 1, and contain all of the recitations of that claim, those claims are also patentable. Also, each of the dependent claims 2-7 and 11 recite additional aspects of the present invention that are simply not disclosed, described, or taught in any of the cited references in Cavallaro. For at least these reasons, all of claims 2-7 and 11 are in condition for allowance.

Moreover, the claimed features of independent amended claim 17 are neither disclosed nor described in Cavallaro. Specifically, as stated above, Cavallaro does not disclose a COR value for a core or a core and intermediate layer whereas amended claim 17 claims the dual layer having a COR value of at least 0.750. Thus amended claim 17 is distinguishable from Cavallaro for the same reasons as amended claim 1.

Since independent claim 17 is patentably distinguishable from Cavallaro,

dependent claims 18-19, which depend or ultimately depend on claim 17, are also patentably distinguishable. Claims 18-19 further recite features in combination with claim 17 that are neither disclosed nor taught in Cavallaro. Thus, claims 18-19 are now also in condition for allowance.


#### **D. Provisional Double Patenting Rejection**

Claims 1-19 were initially rejected under the judicially created doctrine of double patenting over claims 1-38 of U.S. Patent No. 5,803,831. Although Applicants disagree with the Examiner's view, in order to expedite allowance of claims, Applicants herewith present a Terminal Disclaimer to overcome the double patenting rejection.

#### **CONCLUSION**

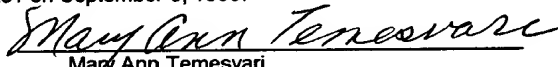
In view of the above claim amendments, distinguishing remarks, and explanations, it is believed that all pending claims are in condition for allowance. Therefore, Applicants respectfully request favorable reconsideration and allowance of claims 1-19 in this application. Claims 20-36 were previously allowed.

Respectfully submitted,  
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#### **CERTIFICATE OF MAILING**

I hereby certify that this **AMENDMENT AND RESPONSE UNDER 37 C.F.R. 1.115** in connection with U.S. Patent Application Serial No. **09/049,410** is being deposited with the United States Postal Service as first class mail in an envelope addressed to the Assistant Commissioner for Patents, Washington, D.C. 20231 on September 8, 1999.

  
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Mary Ann Temesvari

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